

**REMARKS**

**I. Status of the Claims and Amendments**

Claims 1-8 and 30-33 were pending. Applicants acknowledge with appreciation the Office's indication that claims 1-7 are allowed. Office Action, PTOL-326

Applicants have canceled claims 8 and 31-33 without prejudice or disclaimer of that subject matter and they reserve their right to file one or more continuation application based on canceled claims 8 and 31-33. Claim 1 has been amended as the Office suggests to insert "respectively" after the recitation of the accession numbers. Support for this amendment is found at least in the original claim language. Claim 30 has been amended to clarify that the culture is a biologically pure endophyte culture of *Neotyphodium coenophialum* and to insert the "of" missing from the Markush language. Support for these amendments is found throughout the specification and the original claims, for example, original claim 1.

These amendments do not add any new matter.

**II. 35 U.S.C. § 112, first paragraph**

The Office rejects 32 and 33 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. Office Action, page 2. The Office alleges that there is inadequate support in the specification for inclusion of the recitation that the endophyte "has three B100 alleles, each within a range of 154 to 185 base pairs in size. *Id.*

Applicants respectfully disagree. As discussed in the response filed July 21, 2008, support is found not only in the microsatellite mapping reported in Table 2, but

also on page 14, lines 22-26. Nevertheless, Applicants have canceled claims 32 and 33 solely in an effort to expedite prosecution. They reserve the right to prosecute these claims in one or more continuation applications.

**III. 35 U.S.C. § 112, Second Paragraph**

Claims 30-33 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for various reasons. Office Action, page 3.

Applicants have amended claim 30 as suggested and canceled claims 31-33. Accordingly, they respectfully request that the Office withdraw the rejection.

**IV. Objection under 37 C.F.R. 1.75(c)**

The Office objects to claims 8, 31, and 33 under 37 C.F.R. § 1.75(c) as failing to limit the subject matter of the previous claim. Office Action, page 3. Without agreeing with the Office, Applicants have canceled claims 8, 31, and 33, thereby obviating this objection.

**V. Rejections Under 35 U.S.C. §§ 102/103(a)**

Claims 32-33 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly unpatentable over: Waller et al., "Tall Fescues with Novel Endophytes in Tennessee." In Proc 4<sup>th</sup> Int'l Neotyphodium/Grass Interactions Symp (2000) Office action, page 4; Smith et al., "Crop and Soil Environmental Sciences" Pub 418-050 (2002), *id.* at 5; Matthews et al., J. Anim. Sci. 83:1179-85 (2005), *id.* at 6; and Bouton et al., Agronomy J. 94:567-74 (2002), *id.* at 7.

Applicants respectfully traverse each of these rejections for the same reasons discussed in detail in the response filed July 21, 2008, with respect to similar 102/103

rejections made over those same references. The Office presents no evidence that the strains discussed in the cited references possess the same genetic properties as the claimed strains while Applicants have presented evidence that they do not. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. 2112.IV (quoting *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Applicants maintain that the Office has not met this burden.

Solely to expedite prosecution and without in any way agreeing with the Office's position, Applicants have cancelled claims 32 and 33. They reserve their right to prosecute claims corresponding to claims 32 and 33 in one or more continuation applications.

### Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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